

REMARKS

Claims 3-8, 13-18 and 23-28 are pending. Claims 13-18 are objected to because of an informality. Claims 13-18 are rejected under 35 U.S.C. §101. Claims 3-5, 7, 11-15, 17, 21-25 and 27 are rejected under 35 U.S.C. §102(e) as being anticipated by Burnhouse et al. (U.S. Patent Application Publication No. 2002/0056104) (hereinafter "Burnhouse"). Claims 6, 16 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Burnhouse in view of Ismail et al. (U.S. Patent No. 7,146,627) (hereinafter "Ismail"). Claims 8, 18 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Burnhouse in view of Rashkovskiy (U.S. Patent Application Publication No. 2004/0034867) (hereinafter "Rashkovskiy").

Applicants cancelled claims 3, 13-18 and 23-28 without prejudice or disclaimer. Hence, claims 4-8 are pending in the Application. Applicants cancelled claims 3, 13-18 and 23-28 only to expedite the issuance of claims 4-8 and not in response to the Examiner's cited art. Applicants are not conceding in this application that cancelled claims 3, 13-18 and 23-28 are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the subject matter (claims 4-8) indicated by the Examiner as potentially being allowable (see below). Applicants respectfully reserve the right to pursue these and other claims in one or more continuation patent applications.

Applicants thank Examiner Salce for discussing the rejection to claim 5 with Applicants' attorney, Bobby Voigt, on April 7, 2008. Examiner Salce agreed that claim 5, in light of the amendments per the Examiner's request, is potentially allowable. Applicants enclose herewith the arguments that were presented during the discussion as well as included further arguments to clarify the distinguishing features. Further, Applicants will address the features in claim 5 that Examiner Salce requested to be incorporated in claim 5. If, however, Examiner Salce does not agree to allow claims 4-8, Applicants kindly request the Examiner to not enter the present amendments thereby keeping claims 3-8, 13-18 and 23-28 pending.

Applicants amended claim 5 to be rewritten in independent form. Per the Examiner's request, Applicants added the limitation of "in a database" in claim 5 after

the phrase "updating said list of one or more classifications." Further, per the Examiner's request, Applicants added the limitation of "stored in said database" in claim 5 after the phrase "to become a new base set." Additionally, Applicants added the limitation of "after said new base set has been processed" in claim 5 after the phrase "according to said new base set." The Examiner requested Applicants to add these additional limitations in order to clarify the claimed subject matter for the Examiner.

Further, Applicants amended claims 4 and 6-8 to be dependent upon claim 5. Applicants deleted the language in claims 6-8 that also appeared in claim 5.

Hence, no prosecution history estoppel arises from the amendments to claims 4-8. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 4-8 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

As noted above, claim 5 is rejected under 35 U.S.C. §103(a) as being anticipated by Burnhouse. The Examiner cites paragraph [0036] of Burnhouse as disclosing "wherein if there are differences between said list of one or more classifications associated with said plurality of television stations and said tags then the method further comprises the steps of: updating said list of one or more classifications in a database associated with said plurality of television stations to become a new base set stored in said database" as recited in claim 5. Appellants respectfully traverse.

Burnhouse instead discloses that CPU 29 generates a table of pointers 401 to the EPG stored in the memory. [0036]. Burnhouse further discloses that the table 401 is used for changing the order of channels or programs according to the information to be presented in the guide to the user. [0036].

Hence, Burnhouse discloses a table of pointers where the table is used for changing the order of channels or programs.

There is no language in the cited passage that discloses updating a list of one or more classifications. Instead, Burnhouse simply discloses changing the order of channels. Neither is there any language in the cited passage that discloses updating a list of one or more classifications in a database. Neither is there any language in the cited passage that discloses updating a list of one or more classifications in a database associated with the plurality of television stations to become a new base set. Neither is there any language in the cited passage that discloses updating a list of one or more classifications in a database associated with the plurality of television stations to become a new base set stored in the database. Neither is there any language in the cited passage that discloses updating a list of one or more classifications in a database associated with the plurality of television stations to become a new base set stored in the database if there are differences between the list of one or more classifications associated with the plurality of television stations and the tags. Thus, Burnhouse does not disclose all of the limitations of claim 5, and thus Burnhouse does not anticipate claim 5. M.P.E.P. §2131.

Further, the Examiner, during the discussion of the rejection of claim 5 with Applicants' attorney on April 7, 2008, indicated that the Examiner interprets "base set" to mean a category folder that includes sub-category folders. For example, there could be a category folder for "drama" and sub-category folders for "drama-television" and "drama mini-species" and so forth. This is not consistent with the definition of a "base set" in Applicants' Specification. Applicants kindly direct the Examiner's attention to at least page 18, lines 23-24 of Applicants' Specification which discusses that the updated list may then become the base set list of one or more classifications associated with one or more television stations. The pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000); M.P.E.P. §2111. The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. §2111. Since the Examiner has not provided a reasonable interpretation consistent with Applicants' Specification or consistent with the interpretation that

those skilled in the art would reach, the Examiner has not presented a *prima facie* case of anticipation for rejecting claim 5. M.P.E.P. §2111.

Further, the Examiner cites Figures 9-10 of Burnhouse as disclosing "wherein if there are differences between said list of one or more classifications associated with said plurality of television stations and said tags then the method further comprises the steps of:... displaying one or more folders associated with one or more classifications for said plurality of television stations on said display according to said new base set" as recited in claim 5. Appellants respectfully traverse and assert that there is no language in the description of Figures 9 and 10 that discloses displaying folders associated with classifications for the television stations on the display according to the new base set. Neither is there any language in the description of Figures 9 and 10 that discloses displaying folders associated with classifications for the television stations on the display according to the new base set after the new base set has been processed. Thus, Burnhouse does not disclose all of the limitations of claims 5, and thus Burnhouse does not anticipate claim 5. M.P.E.P. §2131.

I. OBJECTIONS TO THE CLAIMS:

The Examiner has objected to claims 13-18 because the claim limitation of "machine readable medium" is not allegedly supported by the Specification. Office Action (2/5/2008), page 3. Applicants cancelled claims 13-18. Hence, the objections to claims 13-18 are moot.

II. REJECTIONS UNDER 35 U.S.C. §101:

The Examiner has rejected claims 13-18 under 35 U.S.C. §101 because the claimed inventions are allegedly directed to non-statutory subject matter. Office Action (2/5/2008), page 3. Applicants cancelled claims 13-18 and hence the rejections to claims 13-18 are moot.

III. REJECTIONS UNDER 35 U.S.C. §102(e):

The Examiner has rejected claims 3-5, 7, 11-15, 17, 21-25 and 27 under 35 U.S.C. §102(e) as being anticipated by Burnhouse. As discussed above, Applicants cancelled claims 3, 11-15, 17, 21-25 and 27 to expedite the issuance of claims 4-5 and

7. The reasons for the allowance of claim 5 are provided above to aid the Examiner. Claims 4 and 7 are amended to be dependent upon claim 5. Hence, claims 4 and 7 are not anticipated by Burnhouse for at least the reasons that claim 5 is allowable.

IV. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 6, 16 and 26 under 35 U.S.C. §103(a) as being unpatentable over Burnhouse in view of Ismail. Further, the Examiner has rejected claims 8, 18 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Burnhouse in view of Rashkovskiy. As discussed above, Applicants cancelled claims 16, 26, 18 and 28 to expedite the issuance of claims 6 and 8. The reasons for the allowance of claim 5 are provided above to aid the Examiner. Claims 6 and 8 are amended to be dependent upon claim 5. Hence, claims 6 and 8 are allowable for at least the reasons that claim 5 is allowable.

V. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 4-8 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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